

Remarks

Claims 13-14, 20, 33-35, 40, 46, and 52-55 have been amended, and claims 1-12, 15-16, 21-22, 26-32, and 36-37 have been cancelled without prejudice to or disclaimer of the underlying subject matter. This application presently contains claims 13-14, 17-20, 23-25, 33-35, and 38-55. Support for these amendments may be found in the original claims, the figures, and throughout the specification, *e.g.*, at page 1, lines 2-6; page 3, lines 11-15; page 7, lines 10-20; and page 8, line 22 through page 9, line 15. No new matter is added by these amendments.

Applicants respectfully request entry of the foregoing amendments and submit that these amendments put the application in condition for immediate allowance or appeal.

A. Information Disclosure Statement

Applicants thank the Examiner for returning an initialed copy of Form PTO-1449 that Applicants had filed on July 27, 2004.

B. Withdrawal of Objections and Rejections

Applicants thank the Examiner for indicating that the previous objection to claims 8, 12, 16, 22, 24, 28, and 32 is withdrawn in view of Applicants' amendment filed April 7, 2004.

Applicants appreciate that the Examiner has noted that the previous rejection of claims 7, 8, 12, 15, 16, 21, 22, and 26-32 under the judicially-created doctrine of obviousness-type double patenting has been withdrawn in view of Applicants' amendment filed April 7, 2004. Applicants also appreciate that, in view of Applicants' amendment filed April 7, 2004, the Examiner has withdrawn the previous rejection of claims 6-32 under 35 U.S.C. § 112, first paragraph, and the previous rejection of claims 7-9, 15-17, 20-25, and 27-29 under 35 U.S.C. § 112, second paragraph. Applicants also thank the Examiner for indicating that the previous rejection of claims 6-9 and 12 under 35 U.S.C. § 102(a) is withdrawn in view of Applicants' amendment filed April 7, 2004.

C. Rejection of Claims for Obviousness-Type Double Patenting

Claims 6, 9-11, 13, 14, 17-20, 23-25, 33-35, 38-44, 46-50, 54 and 55 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as purportedly being unpatentable over claims 1-3, 7-13, 27, 30-33, 37-43, 57-60 and 64-70 of co-pending U.S. Appl. Ser. No. 10/183,091 and claims 1-3, 7-13, 27, 30-33, 37-43, 57-60, and 64-70 of U.S. Appl. Ser. No. 10/364,045. Office Action at pages 3-6.

Applicants respectfully request that the Examiner continue to hold these rejections in abeyance until allowable subject matter is indicated in the present application.

D. Rejection of Claims Under 35 U.S.C. § 112, Second Paragraph

Claims 6, 9-11, 13, 14, 17-20, 23-25, 33, 34-39, 46-53 and 55

Claims 6, 9-11, 13, 14, 17-20, 23-25, 33, 34-39, 46-53 and 55 stand rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite in the recitation of “bone-pathobolism.” Office Action at page 6. Applicants respectfully disagree. Nevertheless, in order to facilitate prosecution, and without acquiescing to the propriety of the rejection, Applicants have amended the claims to recite “a bone-pathobolism selected from the group consisting of osteoporosis, hypercalcemia and chronic articular rheumatism.” Applicants therefore respectfully request withdrawal of this rejection under 35 U.S.C. § 112, second paragraph.

Claims 13, 14, 17-19, 34, 38, 46-51 and 55

Claims 13, 14, 17-19, 34, 38, 46-51 and 55 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite on the grounds that the claims allegedly omit an essential step which is “the effective amount of human OCIF protein or a homolog thereof administered.” Office Action at pages 6-7. Applicants respectfully disagree. Nevertheless, in order to facilitate prosecution, and without acquiescing to the propriety of the rejection, Applicants have amended the claims to recite “administering an effective amount of said human OCIF protein.”

Applicants therefore respectfully request withdrawal of this rejection under 35 U.S.C. § 112, second paragraph.

E. Rejection of Claims Under 35 U.S.C. § 103(a)

Claims 6, 9-10, 36 and 37 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Goldenberg *et al.* (WO 98/46211, October 22, 1998). Office Action at page 7. In order to facilitate prosecution, and without acquiescing to the Examiner's characterization of Goldenberg *et al.* nor acquiescing to the propriety of the Examiner's rejection, Applicants have cancelled claims 6, 9-10, 36 and 37. In light of these remarks, Applicants respectfully submit that the rejection under 35 U.S.C. § 103(a) has been rendered moot.

Conclusion

In view of the foregoing arguments and amendments, each of the presently pending claims is believed to be in immediate condition for allowance. All of the stated grounds of rejection have been traversed, accommodated, or rendered moot. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and pass this application to issue. The Examiner is encouraged to contact the undersigned at 202.942.5512 should any additional information be necessary for allowance.

Respectfully submitted,



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